

REMARKS

Claims 7 and 9-11 are pending in this application. Claim 11 has been amended without prejudice and acquiescence. No new matter has been added as a result of the claim amendment.

The issues outstanding in this application are as follows:

- Claims 7 and 9 are rejected under 35 U.S.C. § 102(e) as being anticipated by Tankersley (U.S. Patent No. 6,957,915) as evidenced by Hanyu et al. (U.S. Publication No. 2002/0176974);
- Claim 11 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Tankersley (U.S. Patent No. 6,957,915);
- Claim 10 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Tankersley (U.S. Patent No. 6,957,915) in view of Jerdee et al (U.S. Patent No. 6,333,087).

I. Claims 7 and 9; 35 U.S.C. § 102(e)

Claims 7 and 9 are rejected under 35 U.S.C. § 102(e) as being anticipated by Tankersley (U.S. Patent No. 6,957,915) as evidenced by Hanyu *et al.* (U.S. Publication No. 2002/0176974). The Applicants respectfully disagree.

Anticipation of a claim is only established where “each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed.Cir. 1987), Applicants assert that Tankersley fails to teach all elements of the independent claim 7.

On page 2 of the Action, the Examiner asserts that Tankersley discloses a sheet material and a package that is compostable; the film has a total of three layers and the inside layer has a lower seal initiation temperature than the outer and exterior layers. With this interpretation of

the prior art, the Examiner asserts that the inside layer corresponds to the second sealable layer and the outer and exterior layers correspond to the first sealable layer. For example, claim 7 recites “the second sealable layer has a lower heat-sealing initiation temperature than the material of the first sealable layer.”

However, on page 2 of the Action, the Examiner states “the inside layer also has a higher hot tack than the outer and exterior layers.” Using the correlation between the prior art and the present invention as established by the Examiner, the Examiner’s statement “the inside layer (the second sealable layer) also has a higher hot tack than the outer and exterior layers (first sealable layer)” shows that the prior art does not teach each and every element as set forth in claim 7. Claim 7 states “said first region has a relatively high sealing strength, and said second region has a relatively low sealing strength.” Tankersley teaches the opposite strength relationship between the first and second regions as recited in the present invention. Therefore, Tankersley does not anticipate the claims.

If an independent claim is not anticipated under 35 U.S.C. § 102(e), then any claim depending therefrom is by definition not anticipated. Applicant respectfully submit that claim 9 depend at least in part from independent claim 7. Accordingly, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection of claims 7 and 9 under 35 U.S.C. § 102(e) as being anticipated by Tankersley (U.S. Patent No. 6,957,915) as evidenced by Hanyu *et al.* (U.S. Publication No. 2002/0176974).

II. Claim 11; 35 U.S.C. § 103(a)

Claim 11 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Tankersley (U.S. Patent No. 6,957,915). In view of the currently amended claim, the Applicants respectfully disagree.

Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), controls the consideration and determination of obviousness under 35 U.S.C. 103(a); *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734–35, 167 L. Ed. 2d 705, 715 (U.S. 2007). The four factual inquiries enunciated therein for determining obviousness are: (1) determining the scope and contents of the prior art;

(2) ascertaining the differences between the prior art and the claims in issue; (3) resolving the level of ordinary skill in the pertinent art; and (4) evaluating evidence of secondary considerations.

In this case, neither the level of ordinary skill in the art, nor secondary considerations are at issue. However, in order to assess the scope and content of the prior art properly, a thorough understanding of the invention must be acquired by studying Applicant's claims and the specification. M.P.E.P. § 2141. Thus, the inquiry begins with construction of Applicant's claims. Next, when ascertaining the differences between the prior art and the claims at issue, both the invention and the prior art references as a whole must be considered, and *all* claim limitations must be considered when determining patentability of Applicant's invention. M.P.E.P. §§ 2141; 2143. When this is properly done in this case, as shown below, it becomes clear that differences exist that preclude obviousness. As shown below, this requirement is not met in this case, and no *prima facie* case for obviousness is made.

Claim 11 has been amended to incorporate the limitation of "said first region has a relatively high peel strength, and said second region has a relatively low peel strength." Tankersley fails to teach all of the claim limitations as amended. Therefore, no *prima facie* case for obviousness is made and the Applicants respectfully request that the rejection be removed.

III. Claim 10; 35 U.S.C. § 103(a)

Claim 10 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Tankersley (U.S. Patent No. 6,957,915) in view of Jerdee et al (U.S. Patent No. 6,333,087). The Applicants respectfully traverse.

The Applicants rely upon the above remarks as to why claim 7 is not anticipated by Tankersley. To summarize these remarks, Tankersley does not teach the limitation "said first region has a relatively high sealing strength, and said second region has a relatively low sealing strength." Jerdee et al. fails to cure this defect. The combination of Tankersley and Jerdee does not account for all claim limitations as recited in claim 7. Therefore, no *prima facie* case for obviousness has been made.

If an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is by definition non-obvious. Applicant respectfully submits that claim 10 depend at least in part from independent claim 7. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection of claim 10 under 35 USC 103(a) as having subject matter unpatentable over Tankersley (U.S. Patent No. 6,957,915) in view of Jerdee et al (U.S. Patent No. 6,333,087).

IV. Conclusion

In view of the above, applicant believes the pending application is in condition for allowance.

Applicants believes no fee is due with this response other than the fees for Petition of Extension of Three Months and a Request for Continued Examination (RCE) under 37 C.F.R. § 1.114. However, if a fee is due, please charge our Deposit Account No. 06-2375, under Order No. HO-P03292US0 from which the undersigned is authorized to draw.

Dated: June 22, 2009

Respectfully submitted,

Electronic signature /Jan K. Simpson/
Jan K. Simpson
Registration No.: 33,283
FULBRIGHT & JAWORSKI L.L.P.
Fulbright Tower
1301 McKinney, Suite 5100
Houston, Texas 77010-3095
(713) 651-5151
(713) 651-5246 (Fax)
Attorney for Applicant